



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,222	09/08/2003	Morton M. Mower	302527US78	1067
22850	7590	08/17/2010		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER KAHELIN, MICHAEL WILLIAM	
			ART UNIT 3762	PAPER NUMBER
			NOTIFICATION DATE 08/17/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

Office Action Summary

Application No.

10/656,222

Applicant(s)

MOWER, MORTON M.

Examiner

MICHAEL KAHLIN

Art Unit

3762

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 20, 27, 28, 34, 67 and 69-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 20, 27, 28, 34, 67 and 69-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/18/2010 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 20, 27, 28, 34, 67, and 69-71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The "Remarks" of 5/18/2010 and the declaration of 1/21/2010 indicate that delivering stimulation to "only a left ventricle" requires a particular placement and/or type of septal electrode. The specific type of electrode and method of installing the electrode appears to be described in U.S. Patent No. 5,728,140 to Salo (see par. 058 of Applicant's disclosure). However, the examiner was unable to locate an adequate incorporation by reference of this

document. See 37 C.F.R. 1.57(b)(1). Since the subject matter of this insulated/uninsulated configuration is "essential subject matter" needed to provide written description for the claims, and has not been properly incorporated, the disclosure is lacking written description of an electrode that is implanted in the right septal wall and stimulates only the left ventricle.

4. Claims 1, 20, 27, 28, 34, 67, and 69-71 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Elements and steps critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The "Remarks" of 5/18/2010 and the declaration of 1/21/2010 indicate that delivering stimulation to "only a left ventricle" requires a particular placement of the septal electrode. The disclosure does not indicate where this particular location is or how to determine the location, but does indicate that the type of electrode and method of installing the electrode is disclosed in U.S. Patent No. 5,728,140 to Salo. It would appear that delivering stimulation to "only a left ventricle" requires the insulated/uninsulated configuration shown in, e.g., Figure 2 of Salo and described at the top of column 2. However, the examiner was unable to locate an adequate incorporation by reference of this document. See 37 C.F.R. 1.57(b)(1). Since the subject matter of this insulated/uninsulated configuration is "essential subject matter" needed to provide enablement for the claims, and has not been properly incorporated, the disclosure is not enabling.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, 20, 27, 28, 34, 67, and 69-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu et al. (US 2003/0105496, hereinafter "Yu") in view of Salo (US 5,728,140, hereinafter "Salo").

7. In regards to claims 1, 27, 34, 67, and 71, Yu discloses providing a first electrode to the left ventricle coronary vein, a second electrode to the septum, and performing intrachamber resynchronization with the electrodes (pars. 0013, 0027 and 0035). Yu does not explicitly disclose that the septal electrode 144 delivers stimulation to only the left ventricle. However, Salo teaches a septal helical electrode that delivers stimulation to only the left ventricle (col. 1, line 67 to col. 2, line 3) to provide the predictable result of reaching the desired chamber for pacing therapy without the accompanying thrombosis complications. Therefore, it would have been obvious to one having ordinary skill in the art to provide Yu's invention with a septal electrode provides stimulation to only the left ventricle to provide the predictable result of reaching the desired chamber for pacing therapy without the accompanying thrombosis complications.

8. In regards to claims 3 and 69, Yu discloses receiving signals from multiple left ventricular sites (par. 0028).

9. In regards to claims 20 and 70, the electrodes are endocardial electrodes (Fig. 3).
10. In regards to claim 28, delivering includes providing a lead through the SVC, RA, ostium of the coronary sinus, and coronary vein (par. 0027 and Fig. 3).

Response to Arguments

11. Applicant's arguments with respect to claims 1, 3, 20, 27, 28, 34, 67, and 69-71 have been considered but are moot in view of the new ground(s) of rejection. It would appear that Salo enables and provides written description for the claimed invention, but has not been properly incorporated by reference. However, Salo is also available as a prior art teaching and applied above under §103.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL KAHRELIN whose telephone number is (571)272-8688. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Niketa Patel can be reached on (571) 272-4156. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Kahelin/
Examiner, Art Unit 3762